

## REMARKS

This amendment is in response to the Official Action mailed February 6, 2003. In the present paper, Applicant has amended claims 37, 38, 40 and 42, cancelled claims 36 and 41, and has added claims 51-57, including re-presenting dependent claim 42 as new independent claim 51. Claims 37-40, 42 and 51-57 are now presented for the Examiner's consideration in view of the following remarks:

### **Claims 37-40, 42 and 51**

The Examiner has rejected former dependent claim 42 as unpatentable over U.S. Patent No. 5,834,747 to Cooper ("Cooper") in view of U.S. Patent No. 5,623,552 to Lane ("Lane"). Applicants have re-presented that claim in independent form as claim 51, and respectfully traverse the Examiner's rejection of that claim and the corresponding dependent claims for the following reasons.

### *No Prima Facie Case of Obviousness*

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP § 2142 (citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)).

Applicant respectfully submits that, in the present case, the examiner has failed to meet the first of the above criteria, because there is no suggestion or motivation of record, other than applicant's own disclosure, to make the combination suggested by the examiner. As to the Cooper reference, nowhere in that reference is there any suggestion to incorporate a fingerprint reader or, for that matter, any authentication mechanism. Instead, the disclosure teaches a general concept of a changeable information- or pattern-carrying device (Cooper, col 1, lines 21-25).

Cooper includes no discussion of limiting use of the device to a single user. Instead, Cooper teaches away from such a limitation, stating that "The operators may be human, animal or otherwise, and may involve different operators of different persons or types at different times" (Cooper, col. 1, lines 29-31). Cooper therefore discourages the claimed fingerprint reader coupled to the device for writing the account identification data.

The Lane reference nowhere suggests to one skilled in the art that the fingerprint reader should be used to limit the use of multiple identification data to a single user, as claimed in the present application. Instead, as is noted by the Examiner, Lane discloses only a single "first account information data." The magnetic stripe programmer of Lane is used strictly for preventing use of the card by unauthorized persons, by automatically clearing the information after each use and rewriting the same account information after authorization by the fingerprint sensor (Lane, col. 5 line 67 – col. 6 line 12). There is no suggestion in Lane or elsewhere to permit a user who has been authenticated by fingerprint to select among multiple accounts.

*Applicant Discovered Source of a Problem*

Unlike Cooper, Lane or any other reference of record, the Applicant recognized that a device capable of writing multiple account information data on a card requires enhanced security. Applicant clearly asserts in the specification that the device could otherwise be unlawfully used to create multiple copies of cards, etc. (spec. p. 16, line 10 – p. 17, line 2). “[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the ‘subject matter as a whole’ which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103.” M.P.E.P. § 2141.02 (quoting *In re Spinnable*, 405 F.2d 578, 585 (CCPA 1969)). In the present case, the Applicant recognized that the universal magnetic stripe card system of the invention is a source of a security problem, and remedied the problem by making the inventive combination of that system with a fingerprint verification system as claimed in claims 37-40, 42 and 51.

**New Claims 52-57**

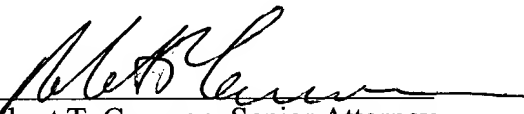
New independent claim 52 and corresponding dependent claims 53-57 have been presented for consideration by the Examiner. Claim 52 contains all the limitations of cancelled claim 32, which is directed to a method of configuring a device for transforming account information on a card. That method uses a database remote from the card and remote from the device used to transform the card. In addition, new claim 52 requires that transaction data is stored in the database, and that that data is used to verify a transaction. The additional limitations of the claim are supported in the specification at least at page 20, line 20 – page 21, line 3.

*Conclusion*

In sum, applicant has re-presented claim 41 in independent form, and argues that that claim is not obvious over the art cited by the Examiner. Likewise, Applicant submits that dependent claims 37-40 and 42 are patentable by reason of their dependency on the re-presented claim. Applicant has also presented new claims 52-57.

Applicant wishes to thank the Examiner for his careful consideration of the above remarks and amendments, and earnestly requests reconsideration and allowance of the claims.

Respectfully,

By   
Robert T. Canavan, Senior Attorney  
Reg. No. 37,592  
Telephone: 908-532-1849

AT&T  
One AT&T Way, Rm. 3A104  
Bedminster, NJ 07921-0752

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